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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,248	08/17/2000	Peter H. Wolf	WOLF-38176	6241

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EXAMINER

CHANG, SABRINA A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,248

Applicant(s)

WOLF, PETER H.

Examiner

Sabrina Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 51-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 51-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 6/20/03 have been fully considered but they are not persuasive.

Examiner reasserts that the combination of MarathonFoto and Garfinkle is proper in that both systems are commercial photo-ordering systems. The addition of Internet ordering, as taught by Garfinkle, to the system of MarathonFoto is obvious to expand the breadth and reach of the services to customers anywhere at anytime.

Examiner also respectfully reasserts that the combination of MarathonFoto/Garfinkle and Siegel is proper in that both MarathonFoto and Siegel are photograph-capturing systems. MarathonFoto is a manual process and Siegel an automated one. It would be obvious to combine the two references in that the automation of a manual process does not lend to an unpredictable result.

Request for Information under 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Specifically, in the applicant's declaration, Paper 6 – submitted 6/20/2003, the applicant refers to the existence of a competing event photography service, MarathonFoto, as early as August 10, 1999. Documents describing the services of MarathonFoto, dated October 25, 1999, served as prior art in rejecting the applicant's claims as recited. Examiner requests that the

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applicant provide any information regarding his awareness of MarathonFoto's product offerings at the time of the event in question – 8/10/1999.

In response to this requirement, please state the specific improvements of the subject matter in claims 1-20, 51-75 over the disclosed prior art, the services provided by MarathonFoto, and indicate the specific elements in the claimed subject matter that provide those improvements. For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure, which describe the claimed structure and acts.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Response to Amendment

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The affidavit filed on 6/20/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the reference, "MarathonFoto".

Submission of evidence regarding the existence or use of the applicant's invention must abide by the guidelines set forth in MPEP 715.07. Applicant must provide an affidavit or declaration establishing possession of either the whole invention claimed or something falling within the claim.

Applicant's reference to a fictitious business name statement does not provide any specific information regarding the features or functionality of the applicant's invention. Applicant's reference to participation in the Solvang Prelude as well as the BRDAA does imply that the applicant offered an event photography service, but does not however disclose any specific features of the service – i.e. searching for photographs by bib number or time.

Further, the applicant's submission of various testimonial evidence, i.e. exhibits A-D, are not procedurally sufficient in that they do not meet the guidelines of MPEP 715.04. Statements made in support of the applicant's affidavit must be notarized or have an acknowledgement by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both.

Applicant has also failed to explicitly indicate that all activities have occurred within the United States. MPEP 715.07(c)

Examiner respectfully reasserts the rejection made on 5/9/2003, restated below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the public use of the service provided by MarathonFoto – as evidenced by the Runnersworld website, dated October 6, 1999 as well as the LaSalle Bank Chicago Marathon website – in view of Official notice regarding competitive sporting events (such as road races), in further view of the Garfinkle U.S. Patent No. 6,017,157.

MarathonFoto discloses a professional photography service that photographs runners at large races. MarathonFoto develops the pictures and sends runners proofs of the photos by mail. MarathonFoto then makes order forms available online so that runners can use their identification information from their proofs to order professionally finished prints. The Runnersworld website indicates that the next obvious step for MarathonFoto would be to enable viewing a runner's proofs online.

In that in any given event there are a substantial number of participants – for example, 4,642 runners participated in the LaSalle Bank Chicago Marathon – it would not have been practical to send each individual runner proofs of photos of all participants, nor would it have been of any use to send each runner proofs of participants at random. Therefore, while it is not explicitly disclosed, it may be reasonably gleaned that the photograph proof sent to the runner is in fact a picture of them during the race.

The excerpts describing the MarathonFoto service do not explicitly disclose that the runners are identified and assigned identifying data that is associated with the photograph. It is possible that the MarathonFoto photographers could approach each individual at an event and

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obtain their name and contact information at the time of the photograph. However, in that the photos are captured during the race, and the runners are otherwise occupied by their running/activity it is more likely that a more efficient method of data capture is used.

Examiner takes official notice that it is notoriously known in the art of administering running and sporting events that participants are given bib numbers for registration and identification purposes. This identification data is typically associated not only with a participant's performance, i.e. their finishing time, but also their name and contact information so that they can be informed of their results. From a runner's finishing time, "split-times" – i.e. the times at which the running crosses different parts of the race – can also be calculated or recorded in association with the participant.

In that MarathonFoto has a "relationship" with the race [See LaSalle website], it would have been obvious to one skilled in the art at the time that instead of obtaining a participant's information on an individual basis, the service instead approaches the race organizers and obtains the full list of participants, their bib numbers (identifying data), their finishing times and contact information all at once, as taught by official notice, in order to expedite the process of distributing the proofs of the photographs.

The combination of MarathonFoto/Official notice does not provide that the photography service catalogs the proofs and photographs on a server and makes the proofs accessible to race participants via the Internet.

Garfinkle et al. teaches a method comprising a service that processes photographs such that photographers can view their pictures in digital form, stored on a central server, via the Internet [Col 7, Line 5]. Photographers can choose specific pictures for professional reprint and

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can order goods/prints from the service. Photographers can also have the digital images sent to them or other people that they designate [Col 7, Line 35].

In that the Runnersworld website already contemplates the probability of on-line proof viewing and already has a commercial component for ordering professional reprints, it would have been obvious to the skilled artisan to modify the service of MarathonFoto/Official Notice to include storing of the proofs on a web accessible server, as taught by Garfinkle et al., in order to give event participants “economical and easy” access to their prints through a secure network [Col 1, Line 53 – Garfinkle].

Claims 5-9, 17, 60, 64-68, and 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over the public use of the service provided by MarathonFoto – as evidenced by the Runnersworld website, dated October 6, 1999 as well as the LaSalle Bank Chicago Marathon website – in view of Official notice regarding competitive sporting events (such as road races), in further view of the Garfinkle et al. U.S. Patent No. 6,017,157, as applied to claim 1, and in further view of Sigel et al. U.S. Patent No. 6,545,705.

The combination of MarathonFoto/Official Notice/Garfinkle does not explicitly provide for:

- Identifying data comprises a code acquired from a component worn by an event participant
- Triggering a camera when the component - which could comprise a passive component, a barcode - passes a predetermined point, where the point includes a sensor which interfaces with the component

Sigel et al. teaches a system for automatically taking photographs at competitive racing events. The system comprises a digital camera directed at a certain point in a race [Figure 1, Abstract]. For example the camera is set up at a human track event. The camera records an

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event in real time at a certain point in the race. When the image changes substantially, i.e. a person passes in front of the camera's field of view, a static image of that instance is captured and stored externally (immediate download to server) or in the alternative that particular moment is "flagged" and indexed [Col 3, Lines 25-47].

Relevant image analysis is triggered by the initial appearance of a hand, arm or leg in the field of view of the camera (triggering the camera) [Col 11, Line 27]. The invention also contemplates that each contestant wears a special identification marker. The marker can be a barcode (passive component) [Col 12, Line 33] or lines or blocks of different colors forming a distinctive combination. In other embodiments an optical character recognition module simply could read the number on the contestant's jersey [Col 12, Line 51]. These markers are used to analyze the captured scene and associate a particular time and image with the identity of the contestant [Col 4, Line 18].

Sigel et al. does not explicitly disclose that the pictures are stored for retrieval by the race participants for potential reprint purchase. However, the system of Sigel et al. seeks to solve the same problem of MarathonFoto/Official Notice/Garfinkle et al., in providing a more efficient and accurate method of cataloging photographs taken at an event where there are many participants. Further the system of Sigel et al. seeks to minimize the efforts of the photographers by automating the picture taking. It would have been obvious to the skilled artisan to modify the photo previewing and ordering system of MarathonFoto/Official Notice/Garfinkle et al. to include the database storing and searching capabilities, i.e. searching by a component worn by the participant, as taught by Sigel et al., in order to automate and increase the efficiency of providing race results and images.

Claims 10-12 and 69-71 rejected under 35 U.S.C. 103(a) as being unpatentable over the public use of the service provided by MarathonFoto – as evidenced by the Runnersworld website, dated October 6, 1999 as well as the LaSalle Bank Chicago Marathon website – in view of Official notice regarding competitive sporting events (such as road races), in further view of the Garfinkle et al. U.S. Patent No. 6,017,157 in further view of Sigel et al. U.S. Patent No. 6,545,705, as applied to claims 5 and 64, and further in view of Hermanns et al. U.S. Patent No. 4,274,076.

The combination of MarathonFoto/Official Notice/Garfinkle/Sigel does not explicitly provide that the component worn by the participant, that triggers the camera, is an inductive circuit or an active component that includes an electronic device having a transmitter.

Hermanns et al. teaches a system for determining the moment when competitors in a race pass the finish line. Race participants wear active transmitters that trigger sensors located at the finish line. Each contestant is associated with a unique transmitter [Col 1, Line 47] and their finishing time can be accurately linked to their unique ID.

In that the method used to trigger the camera in the system of MarathonFoto/Official Notice/Garfinkle/Sigel could have been one of any number of methods, active, using a transmitter, or passive, when the field of view changes, it would have been obvious to one skilled in the art at the time to provide for the triggering of a instance, for example the triggering of a camera, by the crossing of an active transmitter over a sensor, as taught by Hermanns et al., in order to provide the administrator with more flexible methods of automating the camera system.

Claim 13-15, 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over the public use of the service provided by MarathonFoto – as evidenced by the Runnersworld

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website, dated October 6, 1999 as well as the LaSalle Bank Chicago Marathon website – in view of Official notice regarding competitive sporting events (such as road races), in further view of the Garfinkle et al. U.S. Patent No. 6,017,157, in further view of Sigel et al. U.S. Patent No. 6,545,705, as applied to claim 5, and further in view of Gluck U.S. Patent No. 6,532,345.

The system of MarathonFoto/Official Notice/Garfinkle/Sigel does not explicitly provide that:

- The identifying data comprises the date and time the photograph was taken
- An approximate time can be used to search for a particular photograph

Gluck discloses a method for producing and distributing personalized photographic souvenirs for spectators (participants) at an event. In one embodiment, pictures are taken of event participants, without their prior knowledge, and stored at a central server [Fig.4, elements 400c and 406]. For example, photos can be taken while participants are in line at the event and souvenirs can then be indexed by the time and location. Participants can then search for and retrieve photos of themselves using these factors, i.e. time or location, at a later time. [Col 7, Line 28].

In that the combination of MarathonFoto/Official Notice/Garfinkle/Sigel already provides for the storage of an image in association with a participant's identity and time [Sigel - Col 4, Line 18], it would have been obvious to one skilled in the art at the time to further modify the system to allow the user to search for their picture for a potential purchase using their approximate time of crossing the camera, as taught by Gluck, in order to offer the participant as many opportunities as possible to purchase a photo of themselves at the event [Cols 1-2].

The system of MarathonFoto/Garfinkle/Sigel/Gluck does not explicitly provide that the approximate time to used to search for the photograph is a function of the total distance/time ran

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by the event participant and the distance of the photographer from the starting point. However, in that the system of MarathonFoto/Official Notice/Garfinkle/Sigel/Gluck does encompass the recording of a participant's finishing time (T_f), it would have been for the system to be able to calculate the participant's approximate time at a certain point during the race, similar to how runners calculate their "split times" (see Official Notice above), in order to provide a participant with a more efficient means of finding photographs relevant to them.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Included in this Office action is a request for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the requirement for information. The time period for reply to the requirement coincides with the time period for reply to this Office action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703 308 1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC


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